



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,992	12/05/2001	Ritsuko Tanaka	1086.1152	2820
21171	7590	08/26/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			YOUNG, JOHN L	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,992

Applicant(s)

TANAKA, RITSUKO ET AL

Examiner

John L Young

Art Unit

3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

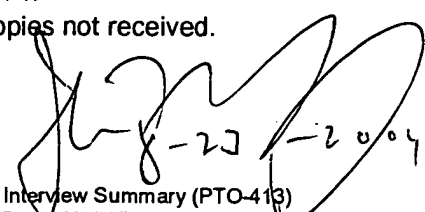
- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3622

NON-FINAL REJECTION

(Paper# 8/23/2004)

DRAWINGS

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM OBJECTIONS

2. Claim 2 is objected to because of inferential claiming. Claim 2, line 3 delete the word "the" and replace it with the word --a--.

Correction required.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-22 are rejected under 35 U.S.C. §103(a) as being obvious over Dedrick US 5,724,521 (03/03/1998) (herein referred to as "Dedrick").

Art Unit: 3622

As per claim 1, Dedrick (col. 3, ll. 28-67) discloses the advertising system *"may be connected . . . as part of an overall wide area network (WAN). . . ."* In this instance the Examiner interprets a wide area network as suggesting the Internet; therefore, this disclosure and inherently shows the "Web page so as to be viewed" elements of claim 1.

Dedrick (col. 18, ll. 1-10) discloses the advertising system *"customize the contents of the information for consumption by the individual end users."*

Dedrick (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6a; FIG. 6b; FIG. 7a; FIG. 7b; col. 1, ll. 7-67; col. 2, ll. 1-20; col. 2, ll. 45-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-17; col. 12, ll. 66-67; col. 13, ll. 1-12; col. 13, ll. 63-67; col. 14, ll. 1-13; col. 15, ll. 4-14; col. 15, ll. 46-64; col. 16, ll. 19-67; col. 17, ll. 1-35; col. 17, ll. 55-67; col. 18, ll. 1-10; and col. 18, ll. 34-64; and whole document) shows: "An advertising server characterized by comprising: a database which registers a supplier for providing a first service and users that have contracts with the supplier; an advertisement preparation unit for preparing an advertisement requested by an advertiser and for placing said advertisement on a Web page so as to be viewed, that is, for providing a second service; and an advertisement utilization unit which, in the case when a user is identified as a contractor user of the first service on the database through the inputted user information, allows the user to view said advertisement on the Web page so as to provide the second service."

Art Unit: 3622

Dedrick lacks an explicit recitation of “Web page” elements and limitations of claim 1, even though Dedrick (col. 3, ll. 28-67) implicitly show same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Dedrick (col. 3, ll. 28-67) implicitly shows “Web page” elements and limitations. . . .”; and it would have been obvious to modify and interpret the disclosure of Dedrick cited above as showing “Web page” elements and limitations. . . .”, because modification and interpretation of the cited disclosure of Dedrick would have provided broad means for *“electronic advertisers to target specific audiences which they believe would be most receptive to their advertisements. . . .”* (see Dedrick (col. 1, ll. 50-57)), based on the motivation to modify Dedrick so as to provide *“electronic advertisements to end users in a consumer best-fit pricing manner. . . .”* (See Dedrick (col. 1, ll. 60-67).

As per claim 2, Dedrick (the col. 3, ll. 28-67) discloses the advertising system *“may be connected . . . as part of an overall wide area network (WAN). . . .”* In this instance the Examiner interprets a wide area network as suggesting the Internet.

Dedrick (col. 18, ll. 1-10) discloses the advertising system *“customize the contents of the information for consumption by the individual end users.”*

Dedrick (the ABSTRACT; FIG. 1; and col. 4, ll. 36-50) discloses: *“The publisher/advertiser . . . is . . . provided with software tools to create electronic*

Art Unit: 3622

information in a wide variety of consumption formats that can be transmitted over the system." The Examiner interprets this disclosure as showing "contractors."

Dedrick (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6a; FIG. 6b; FIG. 7a; FIG. 7b; col. 1, ll. 7-67; col. 2, ll. 1-20; col. 2, ll. 45-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-17; col. 12, ll. 66-67; col. 13, ll. 1-12; col. 13, ll. 63-67; col. 14, ll. 1-13; col. 15, ll. 4-14; col. 15, ll. 46-64; col. 16, ll. 19-67; col. 17, ll. 1-35; col. 17, ll. 55-67; col. 18, ll. 1-10; and col. 18, ll. 34-64) implicitly shows: "An advertising server characterized by comprising: at least, a contractor database that registers contractors that have subscriber contracts with the newspaper dealer; an advertisement preparation unit for preparing an advertisement requested by an advertiser and for placing said advertisement on a Web page so as to be viewed; and an advertisement utilization unit which, in the case when a user is identified as a contractor user on the database through the inputted user information, allows the user to view said advertisement on the Web page."

Dedrick (col. 5, ll. 20-30) discloses *"The advertiser . . . is also able to select certain consumer characteristics which must be met in order for the advertiser . . . to agree to pay a specified fee for delivery of the advertisement to the consumers."* The Examiner interprets this disclosure as suggesting "providing binding arbitration for disputes in connection with a preferred provider."

Art Unit: 3622

Dedrick lacks an explicit recitation of a “Web page.”

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Dedrick (col. 3, ll. 28-67) implicitly shows “Web page” elements and limitations. . . .”; and it would have been obvious to modify and interpret the disclosure of Dedrick cited above as showing “Web page” elements and limitations. . . .”, because modification and interpretation of the cited disclosure of Dedrick would have provided broad means for *“electronic advertisers to target specific audiences which they believe would be most receptive to their advertisements. . . .”* (see Dedrick (col. 1, ll. 50-57)), based on the motivation to modify Dedrick so as to provide *“electronic advertisements to end users in a consumer best-fit pricing manner. . . .”* (See Dedrick (col. 1, ll. 60-67)).

As per claims 3-5, 7-11, 13-14 & 16, Dedrick shows the server according to claim 1.

Dedrick (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6a; FIG. 6b; FIG. 7a; FIG. 7b; col. 1, ll. 7-67; col. 2, ll. 1-20; col. 2, ll. 45-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-17; col. 12, ll. 66-67; col. 13, ll. 1-12; col. 13, ll. 63-67; col. 14, ll. 1-13; col. 15, ll. 4-14; col. 15, ll. 46-64; col. 16, ll. 19-67; col. 17, ll. 1-35; col. 17, ll. 55-67; col. 18, ll. 1-10; and col. 18, ll. 34-64; and whole document) implicitly shows most of the elements of claims 3-5, 7-11, 13-14 & 16; however,

Art Unit: 3622

Dedrick lacks explicit recitation of the "Web page" elements and limitations of claims 3-5, 7-11, 13-14 & 16.

"Official Notice" is taken that both the concepts and the advantages of all of the the elements and limitations (including the "Web page" elements and limitations) of claims 3-5, 7-11, 13-14 & 16 were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Dedrick (col. 3, ll. 28-67) implicitly shows all of the elements and limitations (including the "Web page" elements and limitations) of claims 3-5, 7-11, 13-14 & 16; and it would have been obvious to modify and interpret the disclosure of Dedrick cited above as showing shows all of the elements and limitations (including the "Web page" elements and limitations) of claims 3-5, 7-11, 13-14 & 16, because modification and interpretation of the cited disclosure of Dedrick would have provided broad means for *"electronic advertisers to target specific audiences which they believe would be most receptive to their advertisements. . . ."* (see Dedrick (col. 1, ll. 50-57)), based on the motivation to modify Dedrick so as to provide *"electronic advertisements to end users in a consumer best-fit pricing manner. . . ."* (See Dedrick (col. 1, ll. 60-67)).

As per claims 6, 12, 15 & 17, Dedrick shows the server of claim1.

Dedrick (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3; FIG. 4; FIG. 5; FIG. 6a; FIG. 6b; FIG. 7a; FIG. 7b; col. 1, ll. 7-67; col. 2, ll. 1-20; col. 2, ll. 45-67; col. 3, ll. 1-67; col.

Art Unit: 3622

4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-67; col. 10, ll. 1-67; col. 11, ll. 1-67; col. 12, ll. 1-17; col. 12, ll. 66-67; col. 13, ll. 1-12; col. 13, ll. 63-67; col. 14, ll. 1-13; col. 15, ll. 4-14; col. 15, ll. 46-64; col. 16, ll. 19-67; col. 17, ll. 1-35; col. 17, ll. 55-67; col. 18, ll. 1-10; and col. 18, ll. 34-64; and whole document) implicitly shows most of the elements of claims 6, 12, 15 & 17; however,

Dedrick lacks explicit recitation of some of the elements and limitations of claims 6, 12, 15 & 17.

"Official Notice" is taken that both the concepts and the advantages of all of the elements and limitations claims 6, 12, 15 & 17 were well known and expected in the art by one of ordinary skill at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Dedrick (col. 3, ll. 28-67) implicitly shows all of the elements and limitations of claims 6, 12, 15 & 17; and it would have been obvious to modify and interpret the disclosure of Dedrick cited above as showing shows all of the elements and limitations of claims 6, 12, 15 & 17, because modification and interpretation of the cited disclosure of Dedrick would have provided broad means for *"electronic advertisers to target specific audiences which they believe would be most receptive to their advertisements. . . ."* (see Dedrick (col. 1, ll. 50-57)), based on the motivation to modify Dedrick so as to provide *"electronic advertisements to end users in a consumer best-fit pricing manner. . . ."* (See Dedrick (col. 1, ll. 60-67)).

Art Unit: 3622

Independent claim 18 is rejected for substantially the same reasons as independent claim 1.

Independent claim 19 is rejected for substantially the same reasons as independent claim 1.

Independent claim 20 is rejected for substantially the same reasons as independent claim 1.

Independent claim 21 is rejected for substantially the same reasons as independent claim 1.

Independent claim 22 is rejected for substantially the same reasons as independent claim 1.

RESPONSE TO ARGUMENTS

4. Applicant's arguments (Amendment filed 7/8/2004) have been considered but are unpersuasive for the following reasons

Applicant's arguments are moot based on new grounds of rejection necessitated by Applicant's amendments to the claims.

Art Unit: 3622

CONCLUSION

5. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Serial Number: 10/001,992

(Tanaka et al.)

10

Art Unit: 3622

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


John L. Young

**JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER**

Primary Patent Examiner

August 23, 2004